

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte CORY O. NYKOLUK

Appeal 2008-1778
Application 10/875,394
Technology Center 3700

Decided: August 4, 2008

Before TONI R. SCHEINER, LORA M. GREEN, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a towing member that is configured to be joined to a piece of baggage. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

Background

“A typical towable piece of baggage generally includes a pair of wheels and an extendable towing member connected to the piece of baggage” (Spec. 2). The Specification comments that “the towing member of a prior art wheeled-backpack is typically supported by the rigid base of the backpack on which the wheels are mounted” (Spec. 5).

Statement of the Case

The Claims

Claims 27-49 are on appeal¹. We will focus on claims 27, 28, 34 and 39, which are representative and reads as follows:

27. A towing member configured to be joined to a piece of baggage having a base, the towing member comprising:
a handle;
a non-extendable portion configured to be fixedly attached to the base at a location interior to the piece of baggage; and
a curved arm slideably received within the non-extendable portion and movable relative to the non-extendable portion along a curved telescoping path between a retracted position and an extended position, the arm having a distal end with the handle proximate thereto, the handle being positioned forward of the base and not positioned over the base when the baggage is in upright position and the arm is in the extended position, the arm having a curved portion that is retracted into the non-extendable portion when in the retracted position.

¹ We note that issues relating to the finality of a rejection are reviewable by way of petition under 37 CFR § 1.181, not by appeal to this Board. *See, e.g., In re Hengehold*, 440 F.2d 1395, 1403 (CCPA 1971).

28. The towing member of claim 27, wherein the arm has a proximal end slidably retained within the non-extendable portion, the arm being uniformly curved along a complete length thereof from the proximal end to the distal end.

34. The towing member of claim 27, further comprising a rigid base having a bottom portion and a pair of wheel wells on opposite ends thereof.

39. A towing member configured to be joined to a piece of baggage having a base, the towing member comprising:
a handle;
a non-extendable portion having an axial length and a curvature along the axial length; and
a curved arm slideably received within the non-extendable portion and movable relative to the non-extendable portion along a curved telescoping path between a retracted position and an extended position, the arm having a distal end with the handle proximate thereto, the handle being positioned forward of the base and not positioned over the base when the baggage is in upright position and the arm is in the extended position, the arm having a curved portion that is retracted into the non-extendable portion when in the retracted position, the arm having a proximal end slidably retained within the non-extendable portion, the arm being uniformly curved along a complete length thereof from the proximal end to the distal end.

The prior art

The Examiner relies on the following prior art references to show unpatentability:

Nykoluk	US 6,942,077	Sep. 13, 2005
Mao	US 6,279,706	Aug. 28, 2001
Gold	US 5,779,248	Jul. 14, 1998
Miyoshi	US 5,908,093	Jun. 1, 1999

Raynor	US 3,549,164	Dec. 22, 1970
Godshaw	US 5,893,495	Apr. 13, 1999

The issues

The rejections as presented by the Examiner are as follows:

- A. Claims 27-49 stand rejected under the ground of nonstatutory obviousness-type double patenting over claims 1-15 of Nykoluk (Ans. 4).
- B. Claims 34 and 45 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite (Ans. 5).
- C. Claims 27-29, 31, 32, 34, 37-44, and 46-48 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gold (Ans. 5).
- D. Claim 33 stands rejected under 35 U.S.C. § 103(a) as being obvious over Gold and Miyoshi (Ans. 6).
- E. Claims 27, 32 and 37 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Raynor (Ans. 6).
- F. Claims 27-29, 32-35, 37-40, 43, 44, 46, 48, and 49 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Miyoshi (Ans. 6).
- G. Claim 36 and 47 stand rejected under 35 U.S.C. § 103(a) as being obvious over Miyoshi and Godshaw (Ans. 6).
- H. Claims 27-49 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Mao² (Ans. 7).

² Unlike every other rejection, the Examiner does not restate the Mao rejection, only arguing the rejection at page 7 of the Answer. Since Appellant fully addresses the Mao rejection, in the interests of complete analysis, we will also address the Mao rejection using the statement in the final rejection.

A. Obviousness-type double patenting over claims 1-15 of Nykoluk

Appellant argues that the “claims of the ’077 Patent may not be used as a template to compile a list of isolated features that may be combined in any possible combination to reject claims as obvious, without regard to the combinations actually claimed in the ’077 Patent” (App. Br. 9). Appellant contends that “claim 1 of the ’077 Patent recites at least six features which the presently pending claim 1 does not, and presently pending claim 27 recites at least six features which claim 1 of the ’077 Patent does not” (App. Br. 10). Appellant states that “[i]t is not believed that it would be considered obvious to one of ordinary skill in the art to make at least the 12 changes identified above to claim 1 of the ’077 Patent that would be necessary to arrive at the invention of present claim 27” (App. Br. 11).

The Examiner responds that

at least claim 14 of US 6,942,077 meets the claimed limitations with respect to the curved towing handle selectively extended upwardly and forwardly from the pack and retracted back toward the pack along an arcuate path curved away from the pack as set forth in claim 1, and a non-extendable portion as shown above. . . The examiner submits that claim 27 of the present application recites, “comprising” that does not exclude other structures into the claim. Thus, the presence of other structures in the claim 14 of US 6,942,077.

(Ans. 7.)

In view of these conflicting positions, we frame the non-statutory obviousness type double patenting issue before us as follows:

Are claims 27-49 obvious over the teaching of claims 1-15 of Nykoluk?

Findings of Fact

1. Claim 14 of Nykoluk teaches “a towing handle” (Nykoluk, col. 10, l. 14).
2. Claim 14 of Nykoluk teaches a “non-extending portion of the telescoping member” of the towing handle (Nykoluk, col. 10, ll. 21-22).
3. Claim 14 of Nykoluk teaches “a curved, telescoping member, the telescoping member allowing the handle to be selectively extended upwardly and forwardly from the pack and retracted back toward the pack along an arcuate path curved away from the pack” (Nykoluk, col. 10, ll. 14-18).

Discussion of Obviousness-type double patenting over claims 1-15 of Nykoluk

We find that the relationship of claim 14 of Nykoluk to the instant claim 27 is that of anticipation. Claim 14 of Nykoluk teaches all of the elements necessary for the towing member of claim 27, including a handle (FF 1), a non-extendible portion that is attached to a piece of baggage (FF 2) and a curved telescoping arm which is not positioned over the bag when extended (FF 3).

The proper test for double patenting in such a situation is that a “claim cannot be patentably distinct over anticipatory subject matter.” *Geneva Pharmaceuticals, Inc. v. GlaxoSmithKline PLC*, 349 F.3d 1373, 1383 (Fed. Cir. 2003).

We agree with the Examiner that claim 14 of Nykoluk teaches an article that represents a species of claim 27. Appellant argues that claim 14 does not teach a “non-extendable portion configured to be fixedly attached

to the base” (App. Br. 15) and that the handle is “not positioned over the base when the baggage is in an upright position (*id.*). However, this is contradicted by the plain language of claim 14. Claim 14 states that the handle has “non-extending portion of the telescoping member” (Nykoluk, col. 10, ll. 22-23). Additionally, claim 14 requires that the handle is “selectively extended upwardly and forwardly from the pack” (Nykoluk, col. 10, ll. 16-17), which will place the handle in a position not over the base when the base is in an upright position. We therefore find that claim 14 of Nykoluk teaches a species of instant claim 27.

Appellant’s arguments regarding the additional elements taught in claim 14 of Nykoluk are not relevant to the obviousness analysis, since claim 14 of Nykoluk anticipates, and therefore renders obvious, instant claim 27. We note that the same features are relied upon to distinguish claim 39, and that claim 39 is also anticipated by claim 14 of Nykoluk.

We affirm the rejection of claims 27 and 39 under the nonstatutory obviousness type double patenting rejection. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 28-38 and 40-49 as these claims were not argued separately.

B. 35 U.S.C. § 112, second paragraph indefiniteness rejection

The Examiner contends that “the claim is confusing in term of identifying the base being part of the handle or not. On claims 27 and 39, applicant defines the base as part of the baggage and excludes the base being part of the towing member, and on the other claims 34 and 45, applicant defines the base as part of the towing member” (Ans. 7).

Appellant argues that the “independent claims 27 and 39 do not positively recite the ‘base’ while claims 34 and 45 do. The claims are therefore submitted to be properly written, are believed to be clear and definite as they stand, and would be readily understood by those in the art when read in light of the specification” (App. Br. 18).

In view of these conflicting positions, we frame the indefiniteness issue before us as follows:

Are claims 34 and 45 indefinite because it is unclear whether the base is part of the handle or part of the towing member?

Discussion of 35 U.S.C. § 112, second paragraph indefiniteness rejection

The Federal Circuit has noted that “[t]he standard of indefiniteness is somewhat high; a claim is not indefinite merely because its scope is not ascertainable from the face of the claims.” *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1342 (Fed. Cir. 2003). Rather, “[a] claim is indefinite if, when read in light of the specification, it does not reasonably apprise those skilled in the art of the scope of the invention.” *Id.*

We agree with the Appellant that claims 34 and 45 are definite. There is no reason why the towing member cannot have a rigid base that is distinct from the base of the baggage. Claim 27 does not require that the towing

member have a base, only that the towing member is configured to be joined to a piece of baggage with a base (*see* Claim 27). Claims 34 and 45 simply add an additional requirement to the towing member itself, which is that the towing member also have a rigid base and that the rigid base include a pair of wheel wells (*see* Claims 34 and 45). The inclusion of this additional requirement does not render claims 34 and 45 indefinite, but simply further specifies the structure of the towing member.

We reverse the rejection of claims 34 and 45 under 35 U.S.C. § 112, second paragraph.

C. 35 U.S.C. § 102(b) rejection over Gold

Appellant argues that “Gold et al. discloses a child carrier/push stroller that is not a piece of baggage, and the lower fixed supports (20) do not meet the recitation of the non-extendable portion of claim 27 because they are not attached to a base at an interior location” (App. Br. 25). Appellant further contends that Gold doesn’t teach some preamble and body elements “which are submitted to define structure of the claimed components in terms of interrelationships with other recited components and attributes which they possess in the completed assembly. The structure, relationships, and attributes recited in the claims may not be ignored under a proper reading of the claims” (App. Br. 26).

The Examiner “submits that the limitation following ‘configured to be fixedly attached’ is an intended use. The claims so far only recite a non-extendable portion, a curved arm.” (Ans. 7-8). The Examiner further argues that the “recitation ‘configured to be joined’ has not been given patentable weight because the recitation occurs in the preamble” (Ans. 8).

In view of these conflicting positions, we frame the anticipation issue before us as follows:

Does the towing member of Gold satisfy all of the limitations of claim 27?

Findings of Fact

4. Gold teaches that a “[h]andlebar apparatus **25** is mounted to the rear support frame member **12** using handlebar mounting devices **22**” (Gold, col. 3, ll. 8-9).

5. Gold teaches that the “handlebar unit **25** may incorporate an extendable handlebar system thus allowing the height of the push bar **23** to be adjusted” (Gold, col. 3, ll. 17-19).

6. Gold teaches that the “method shown incorporates upper telescoping vertical supports **28** which can slide up and down within the lower fixed supports **20**” (Gold, col. 3, ll. 19-21).

7. Gold discloses that the handlebar unit is curved in figure 4, which is reproduced below.

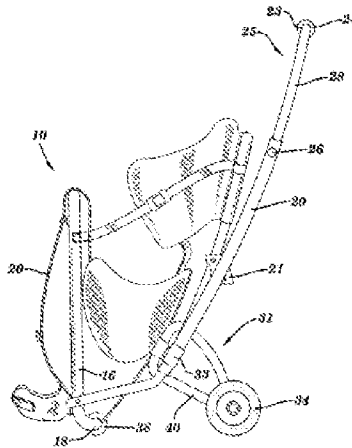


FIG. 4

Figure 4 of Gold shows a child carrier with a curved handle.

Discussion of 35 U.S.C. § 102(b) over Gold

Claim 27

We agree with the Examiner that Gold teaches an article that meets all of the requirements of claim 27. Specifically, Gold teaches a towing member which comprises a handle (FF 4) with an extendible portion (FF 5) and fixed, non-extendible portion (FF 6). Gold discloses that the extendible portion may be curved and retract into the fixed portion (FF 7).

In analyzing the claim language, we give claim phrases their broadest reasonable interpretation. *See, e.g., In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000) (“During examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.”). The argued difference for Gold is whether Gold teaches a towing member which is “configured to be fixedly attached to the base at a location interior to the piece of baggage” (Claim 27).

The argued limitation states the purpose or intended use of the towing member but it does not require that the towing member actually be attached to the interior location of a piece of baggage in order to come within the scope of the claim. Thus, while the claim requires that the towing member be capable of attaching to interior locations of baggage, it does not require that such an attachment, or indeed any attachment to baggage, in order to anticipate or infringe the claim. *See Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003) (“An intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates.”).

We interpret claim 27 as directed towards a towing member with a handle, a non-extendable portion and a curved portion which can be telescoped into the non-extendable portion when retracted. The “configured to be fixedly attached to the base at a location interior to the piece of baggage” language (Claim 27) is not a structural element of the towing member of claim 27. Therefore, Gold anticipates claim 27 since Gold teaches all of the structural elements of claim 27 (FF 4-7).

Claims 28 and 39

We are not persuaded by Appellant’s argument for claims 28 and 39 that the handle bar of Gold is “not uniformly curved along a complete length” (App. Br. 26). Appellant relies upon the fact that the handle bar of Gold has two curved support members which have a nearly 90 degree bend to form the handle (*see* Gold, fig. 3; App. Br. 26). However, claim 28 simply states “the arm being uniformly curved” (claim 28) where the “arm” in claim 28 refers to the “curved arm” in claim 27 that is telescoped into the non extendable

portion. Appellant wants to expand the “arm” to include the “handle”, which is listed as a separate physical structure in claim 27, distinct from the “curved arm” (*see* Claim 27). Thus, properly interpreting the “arm” as referring only to the “curved arm” and not also incorporating the “handle”, the “curved arm” of Gold is uniformly curved from the proximal to distal end, where the distal end is where the handle begins (*see* Claim 27) and the proximal end is the end which is attached to the non-extendible portion (FF 7, Gold, fig. 4).

We affirm the rejection of claims 27, 28 and 39 under 35 U.S.C. § 102(b) over Gold. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 29, 31-32, 34, 37, 38, 40-44, and 46-48 as these claims were not argued separately.

D. 35 U.S.C. § 103(a) rejection over Gold and Miyoshi

Appellant argues that “[t]here is no apparent connection between the disclosure of Gold et al. relating to child carrier/stroller with removable wheel unit and the disclosure of Miyoshi relating to a bag with casters that would logically lead to the combination proposed in the Office Action” (App. Br. 30). Appellant also contends that

Miyoshi is submitted to directly contradict and teach away from the invention of claim 27 wherein the handle is positioned forward of the base and not positioned over the base when the arm is in the extended position. Indeed, Miyoshi teaches precisely the opposite, namely the use of curved rods that position the handle at the middle of the bag between the left and right sides of the bag when extended.

(App. Br. 30.)

The Examiner “submits that both Miyoshi and Gold are related to curved telescoping handle. Thus, to provide additional telescoping portions as taught by Miyoshi would have been obvious” (Ans. 8).

In view of these conflicting positions, we frame the obviousness issue before us as follows:

Would it have been obvious to an ordinary practitioner at the time the invention was made to incorporate multiple telescoping regions as taught by Miyoshi into the towing member of Gold?

Findings of Fact

8. Miyoshi discloses that the “extensible rods **55** are rods that can be extended in two or three segments” (Miyoshi, col. 4, ll. 46-47).

Discussion of 35 U.S.C. § 103(a) rejection over Gold and Miyoshi

In *KSR*, the Supreme Court stated that

[t]he principles underlying these cases are instructive when the question is whether a patent claiming the combination of elements of prior art is obvious. When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability.

KSR Int’l v. Teleflex Inc., 127 S. Ct. 1727, 1740 (2007).

Applying the *KSR* standard of obviousness to the findings of fact (FF 4-8), we conclude that there the combination of multiple telescoping sections as taught by Miyoshi in the towing member of Gold represents a combination of known elements which yield the predictable result of superior retraction through the use of multiple telescoping sections. Such a

combination is merely a “predictable use of prior art elements according to their established functions.” *KSR Int’l*, 127 S. Ct. at 1740.

We also reject Appellant’s argument that Miyoshi teaches away from the invention because Miyoshi teaches a curved arm which is shown as curved over the baggage (*see, e.g.*, Miyoshi, fig. 6). Like our appellate reviewing court, “[w]e will not read into a reference a teaching away from a process where no such language exists.” *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1364 (Fed. Cir. 2006). There is no teaching in Miyoshi which teaches that multiple telescoping members must be oriented in only one direction.

We affirm the rejection of claim 33 under 35 U.S.C. § 103(a) over Gold and Miyoshi.

E. 35 U.S.C. § 102(b) rejection over Raynor

Appellant argues that “Raynor discloses a combination baby stroller and vehicle seat bearing no apparent relation to the towing member configured to joined to a piece of baggage as claim 27 recites when all words of the claims are given effect” (App. Br. 27). Appellant further argues that the “body (20) is clearly not a piece of baggage and the members (35) extend on exterior edges, rather than being configured to be fixedly attached at a location interior to the body (20)” (App. Br. 27).

The Examiner “submits that the limitation following ‘configured to be fixedly attached’ is an intended use. The claimed subject matter is a handle. The recitation of the intended use handle attached to a piece of baggage does not impart any handle over the handles in Raynor” (Ans. 8).

In view of these conflicting positions, we frame the anticipation issue before us as follows:

Does the towing member of Raynor satisfy all of the limitations of claim 27?

Findings of Fact

9. Raynor teaches “a pair of slidable arcuate handle members **36** configured to conform to the curvatures of the tubular members or [sic] sockets **35**” (Raynor, col. 2, ll. 30-32).

10. Raynor teaches that a “pair of parallel arcuate tubular members **35** extend along the tops of the sidewalls **23** from the front wall **22** to a point slightly above and to the rear of back **24**” (Raynor, col. 2, ll. 27-29).

11. Raynor teaches that “when handle members **36** are telescoped inwardly they assume the position shown in dotted lines adjacent the back **50** of a vehicle seat **51** as shown in FIG 1” (Raynor, col. 2, ll. 49-52).

12. Raynor teaches that the telescoping arms are curved (Raynor, fig. 1).

Discussion of 35 U.S.C. § 102(b) over Raynor

We agree with the Examiner that Raynor teaches an article that meets all of the requirements of claim 27. Specifically, Raynor teaches a towing member which comprises a handle (FF 9) with an extendible portion (FF 11) and fixed, non-extendible portion (FF 10). Raynor discloses that the extendible portion may be curved and retract into the fixed portion (FF 11-12).

As discussed above, we give claim phrases their broadest reasonable interpretation. *See, e.g., In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)

(“During examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.”).

The argued difference for Raynor is whether Raynor teaches a towing member which is “configured to be fixedly attached to the base at a location interior to the piece of baggage” (Claim 27).

The argued limitation states the purpose or intended use of the towing member but it does not require that the towing member actually be attached to the interior location of a piece of baggage in order to come within the scope of the claim. Thus, while the claim requires that the towing member be capable of attaching to interior locations of baggage, it does not require such an attachment, or indeed any attachment to baggage, in order to anticipate or infringe the claim. *See Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003) (“An intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates.”).

We affirm the rejection of claim 27 under 35 U.S.C. § 102(b) over Raynor. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 32 and 37 as these claims were not argued separately.

F. 35 U.S.C. § 102(b) rejection over Miyoshi

Appellant argues that

[i]ndependent claims 27 and 39 each recite that the handle is “positioned forward of the base and not positioned over the base when the baggage is in upright position and the arm is in the extended position.” Miyoshi teaches the use of curved rods that position the handle directly over the middle of the bag between the left and right sides of the bag when the bag is an upright position and when the telescoping rods are extended.

(App. Br. 28.)

The Examiner argues that the claims are “only directed to a handle” (Ans. 9). The Examiner contends that “the limitations with respect to the baggage do not impart any structure over the handle in Miyoshi. The handle in Miyoshi can be configured to be [in] position over the base” (Ans. 9).

In view of these conflicting positions, we frame the anticipation issue before us as follows:

Does the towing member of Miyoshi satisfy all of the limitations of claim 27?

Findings of Fact

13. Miyoshi teaches that with “the bag mounted with the handle at the middle of the upper face of the bag body, it is necessary to fix extensible rods **25** of the handle **23** to the inside of the bag body **24**” (Miyoshi, col. 2, ll. 26-28).

14. Miyoshi teaches that “the extensible rods are curved so as to be located at the middle of the upper face between the right and left sides of the bag body” (Miyoshi, col. 3, ll. 6-8).

Discussion of 35 U.S.C. § 102(b) over Miyoshi

As discussed above, we give claim phrases their broadest reasonable interpretation. *See, e.g., In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000) (“During examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.”).

The claim language at issue in the Miyoshi rejection is the requirement in claim 27 for “the handle being positioned forward of the base and not positioned over the base when the baggage is in upright position and the arm

is in the extended position” (Claim 27). This statement is more than a statement of intended use because it requires that the curvature of the arm be convex on the side of the handle which is “configured to be fixedly attached to the base” (Claim 27).

However, while Miyoshi teaches a handle with curved rods (FF 13-14), the orientation of Miyoshi is for the curvature to be positioned over the base, which is directly opposite of the limitation of claim 27 (*see* Miyoshi, fig. 10).

We are not persuaded by the Examiner’s argument that “the limitations with respect to the baggage do not impart any structure over the handle in Miyoshi” (Ans. 9). The structure of the prior art handle of Miyoshi will not satisfy the curvature requirements of claim 27 unless alterations are made in the mode of attachment of the prior art Miyoshi handle to the baggage, since Miyoshi discloses only one orientation for the handle (*see, e.g.,* Miyoshi, fig. 10). The issue is not whether such alterations might have been obvious, since this is an anticipation rejection. The issue is therefore whether Miyoshi actually teaches a towing member which satisfies the requirements of claim 27. Because the Miyoshi towing member would not attach to a base in a manner necessary to satisfy the curvature requirement, we agree with Appellant that Miyoshi does not teach all of the limitations of claim 27.

We reverse the rejection of claims 27-29, 32-35, 37-40, 43, 44, 46, 48, and 49 under 35 U.S.C. § 102(b) over Miyoshi.

G. 35 U.S.C. § 103(a) rejection over Miyoshi and Godshaw

The Examiner relies on the Miyoshi as discussed above. The Examiner relies on Godshaw to teach “an alternative containing device” (Ans. 6). The Examiner has not identified and we do not find a teaching in Godshaw that

would make up for the deficiency in the Miyoshi discussed above.

Accordingly, we reverse the rejection of claims 36 and 47 under 35 U.S.C. § 103(a) as unpatentable over Miyoshi and Godshaw.

H. 35 U.S.C. § 102(e) rejection over Mao

Appellant argues that the rejection over Mao is overcome by a declaration (App. Br. 19-20). In particular, Appellant argues that the declaration

establishes two alternative evidentiary bases for overcoming the rejection based upon the Mao patent, namely (1) that Applicant actually reduced the invention to practice at a date before the Mao patent was filed in June of 2000 (see paragraph 11F of the declaration discussing a prototype of the invention that was manufactured on or about November of 1999), thereby antedating the Mao reference and removing it from prior art that can be cited against the claims; and (2) that Applicant's invention was subsequently disclosed to Mao and became the basis for Mao's patent application, thereby establishing that Mao's invention was derived from Applicant's earlier work.

(App. Br. 21.)

The Examiner “submits that the 37 CFR 1.132 declaration is not sufficient to over[come] the Mao rejection, since both have the same assignee, TRG, Accessories, LLC” (Ans. 7). The Examiner also argues that “according to the complaint with the US District Court for the Eastern District of Missouri, applicant asserts that the invention of Mao is the same invention as set forth in this application. Thus the application of MPEP § 715, II(B) is entirely applicable” (Ans. 7).

Discussion of 35 U.S.C. § 102(e) over Mao

We begin the analysis of whether the 102(e) rejection may be overcome by a 1.132 declaration by determining under what ground Appellant relies. Appellant's declaration states that "[t]o the extent that the '706 patent describes subject matter that relates to the Claimed Invention of the '033 application, Chen Shou Mao derived and copied such subject matter from me" (Nykoluk Dec. ¶ 5).

"An applicant may also overcome a reference by showing that the relevant disclosure is a description of the applicant's own work" *In re Costello* 717 F.2d 1346, 1349 (Fed. Cir. 1983). The MPEP is consistent with the Federal Circuit, noting that "an affidavit under 37 CFR 1.132 may be submitted to show that the relevant portions of the reference originated with or were obtained from applicant" MPEP § 716.10.

In the instant case, the Nykoluk Declaration unambiguously states that Mao derived the invention from Nykoluk and provides factual evidence to support this position (*see* Nykoluk Dec. ¶ 5-22). The Examiner has provided no evidence which rebuts that provided in the Nykoluk Declaration. We therefore find that Nykoluk has demonstrated derivation as required by the MPEP and *Costello*.

We are not persuaded by the Examiner's reliance on MPEP § 715 II(B), since that section of the MPEP relates to 1.131 declarations designed to antedate a reference, not 1.132 declarations relying upon derivation. Additionally, we note that MPEP § 715 II(B) refers to the "same patentable invention", and this standard is the same as that for statutory double patenting. Claim 1 of Mao clearly incorporates subject matter which differs from the

instant claims, including “luggage”, “shoulder straps”, and a “spherical slot”, none of which are recited in the instant claim 27. Thus, claim 1 of Mao is not drawn to the “same” patentable invention.

We reverse the rejection of claims 27-49 under 35 U.S.C. § 102(b) over Mao.

CONCLUSION

In summary, we affirm the rejection of claims 27 and 39 under the nonstatutory obviousness type double patenting rejection. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 28-38 and 40-49 as these claims were not argued separately.

We reverse the rejection of claims 34 and 45 under 35 U.S.C. § 112, second paragraph.

We affirm the rejection of claims 27, 28 and 39 under 35 U.S.C. § 102(b) over Gold. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 29, 31-32, 34, 37, 38, 40-44, and 46-48 as these claims were not argued separately.

We affirm the rejection of claim 33 under 35 U.S.C. § 103(a) over Gold and Miyoshi.

We affirm the rejection of claim 27 under 35 U.S.C. § 102(b) over Raynor. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 32 and 37 as these claims were not argued separately.

We reverse the rejection of claims 27-29, 32-35, 37-40, 43, 44, 46, 48, and 49 under 35 U.S.C. § 102(b) over Miyoshi. We also reverse the rejection of claims 36 and 47 under 35 U.S.C. § 103(a) as unpatentable over Miyoshi and Godshaw.

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We reverse the rejection of claims 27-49 under 35 U.S.C. § 102(b) over Mao.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED

cdc

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